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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,094	01/21/2004	Karim Batthish	MS#303721.01 (5223)	4553
38779 7590 03/02/2007 SENNIGER POWERS (MSFT) ONE METROPOLITAN SQUARE, 16TH FLOOR ST. LOUIS, MO 63102			EXAMINER SAN JUAN, MARTINJERIKO P	
			ART UNIT	PAPER NUMBER
			2109	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		03/02/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/02/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@senniger.com

Office Action Summary

Application No.

10/762,094

Applicant(s)

BATTHISH ET AL.

Examiner

Martin Jeriko P. San Juan

Art Unit

2109

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/10/04

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

This is response to the following case application:

Non-provisional Application No. 10/762094 filed on January 21, 2004.

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species:

- a. Species 1, claims 1-19, a method or a computer readable medium with executable code performing the method of protecting the identity of one or more hidden recipients of an email message by creating separate emails to be distributed securely to revealed and hidden recipients respectively; and
- b. Species 2, claims 20-21, a computer readable medium performing the method of processing secured emails based on the implementation of recipients being on a secure mailing list.

The species are independent or distinct because the first species is about the protection of the identity of hidden recipients by creating separate secured email messages, while the second species is about the process of securing an email by implementation of a secure mailing list.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

2. During a telephone conversation with Mr. James Barta Jr. on February 16, 2007 (by SPE Joseph Del Sole) a provisional election was made without the indication of traverse to prosecute the invention of Species 1, claims 1-19. Affirmation of this election must be made by applicant in replying to this Office action. Claim 20 and 21

are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg [US PN: 7130887 B2], and further in view of Olkin et al. [US PN: 6584564 B2].

a. With regard to independent claim 1, Goldberg teaches a method for processing multiple/separate email messages, the email message comprising an email header and an email body, the method comprising: creating a first email body; creating a second email body; creating a first email message comprising the first email body [Col 3, Ln 15] and; creating a second email message comprising the second email body [Col 3, Ln 32] and; transmitting the first email message to the one or more revealed recipients [Col 3, Ln 15]; and transmitting the second email message to the one or more hidden recipients [Col 3, Ln 32].

b. With regard to dependent claim 2, Goldberg teaches the method of claim 1 further comprising: determining the one or more revealed recipients of the

email message and determining the one or more hidden recipients of the email message [Col 3, Ln 28].

c. With regard to dependent claim 3, Goldberg teaches the method of claim 2, wherein the email header comprises a TO field, a CC field, and a BCC field, and wherein further the one or more revealed recipients are determined by reference to the TO field and the CC field and the one or more hidden recipients are determined by reference to the BCC field [Col 3, Ln 19].

With regard to claims 1-3, Goldberg does not teach the encryption of email messages. Olkin teaches a secure e-mail system for the purpose of providing security in the transmission of email messages. Olkin et al. discuss encryption of email messages using the public-key, and private-key based systems as being quite popular and is generally attributed to work done by Ron Rivest, Adi Shamir, and Leonard Adleman at the Massachusetts Institute of Technology in the 1970's [US 6584564 B2, Col 2, Ln 12]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the processing of multiple/separate email messages of Goldberg by adding an encryption process as discussed by Olkin et al. for the purpose of providing security in the transmission of email messages such as encrypting the first email body using a first encryption key, and encrypting the second email body using a second

encryption key, such that the encrypted email messages now comprise the encrypted email body and the encryption key.

d. With regard to dependent claim 4, Goldberg teaches the method of claim 1, but does not teach the encryption of email messages. Olkin et al. teach the encryption of email messages wherein the first encryption key and the second encryption key are equivalent [The equivalence of the first encryption key and the second encryption key is interpreted as using a single encryption key, such that the first and second encryption keys are identical. Olkin et al. teach the use of a single encryption key. Col 14, Ln 5], and wherein the first encrypted email body and the second encrypted email body are equivalent [The use of equivalent keys to encrypting identical messages will yield equivalent email bodies.]. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the processing of multiple/separate email messages of Goldberg by adding an encryption process as taught by Olkin et al. for the purpose of providing security in the transmission of email messages.

e. With regard to dependent claim 5, Goldberg teaches the method of claim 1, but does not teach the encryption of email messages using the recipient's certificate to obtain public keys. Olkin teaches a secure e-mail system for the purpose of providing security in the transmission of email messages. Olkin et al. discuss encryption of email messages using the public-key, and private-key

based systems as being quite popular and is generally attributed to work done by Ron Rivest, Adi Shamir, and Leonard Adleman at the Massachusetts Institute of Technology in the 1970's [US 6584564 B2, Col 2, Ln 12]. Olkin et al. further discuss that public keys of recipients are usually published via the recipient's certificate so that "those wishing to send a message can determine keys for intended recipients [US 6584564, Col 2, Ln 55]." Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the processing of multiple/separate email messages of Goldberg by adding an encryption process as discussed by Olkin et al. for the purpose of providing security in the transmission of email messages by using the recipient's certificate to obtain public keys such that, wherein creating the first encrypted email message comprises: locating one or more revealed recipient certificates corresponding to the one or more revealed recipients; obtaining one or more revealed recipient public keys corresponding to the one or more revealed recipients from the one or more revealed recipient certificates; and encrypting, for each of one or more revealed recipients, the first encryption key using the one or more revealed recipient public keys; and wherein the creating the second encrypted email message comprises: locating one or more hidden recipient certificates corresponding to the one or more hidden recipients; obtaining one or more hidden recipient public keys corresponding to the one or more hidden recipients from the one or more hidden recipient certificates; and encrypting, for

each of one or more hidden recipients, the second encryption key using the one or more hidden recipient public keys.

f. With regard to dependent claim 6, Goldberg teaches the method of claim 1, wherein creating the second email message comprises creating one or more email messages corresponding to the one or more hidden recipients, wherein each email message of the one or more email messages comprises the second email body; and wherein the transmitting the second email message comprises transmitting the one or more email messages to the corresponding one or more hidden recipients [Col 3, Ln 28].

g. With regard to dependent claim 7, Goldberg teaches the method of claim 6, wherein the one or more hidden recipients are members of an email mailing list referenced in the email header [Col 3, Ln 28].

With regard to claims 6 and 7, Goldberg does not teach the encryption of email messages. Olkin teaches a secure e-mail system for the purpose of providing security in the transmission of email messages. Olkin et al. discuss encryption of email messages using the public-key, and private-key based systems are quite popular and is generally attributed to work done by Ron Rivest, Adi Shamir, and Leonard Adleman at the Massachusetts Institute of Technology in the 1970's [US 6584564 B2, Col 2, Ln 12]. Olkin et al. further discuss that public keys of

recipients are usually published via the recipient's certificate so that "those wishing to send a message can determine keys for intended recipients [US 6584564, Col 2, Ln 55]." Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the processing of separate email messages of Goldberg by adding an encryption process as discussed by Olkin et al. for the purpose of providing security in the transmission of email messages such that, wherein creating the second encrypted email message comprises creating one or more encrypted email messages corresponding to the one or more hidden recipients, wherein each encrypted email message of the one or more encrypted email messages comprises the second encrypted email body and the second encryption key encrypted for a corresponding hidden recipient; and wherein the transmitting the second encrypted email message comprises transmitting the one or more encrypted email messages to the corresponding one or more hidden recipients.

h. Independent and dependent claims 8-14 are merely the computer-readable medium having computer executable instructions for performing the method of claims 1-7. Claims 8-14 are rejected under the same analysis and rationale of rejecting claims 1-7.

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2. Claim 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg [US PN: 7130887 B2], and further in view of Olkin et al. [US PN: 6584564 B2] and Price III [US PN: 6851049 B1].

a. Dependent claim 15 is merely the computer-readable medium having computer-executable instructions for performing the method of claim 2, wherein determining the one or more hidden recipients of the email message also includes selecting a hidden recipients concealment option; wherein further each of the one or more hidden recipients will receive, depending on the selected hidden recipients concealment option, either a second encrypted email message comprising, for each of one or more hidden recipients, an encrypted version of a second encryption key and a second encrypted email body created by encrypting the email body using the second encryption key, or a corresponding one or more encrypted email messages corresponding to the one or more hidden recipients, wherein each encrypted email message of the corresponding one or more encrypted email messages comprises the second encryption key encrypted for a corresponding hidden recipient and a second encrypted email body created by encrypting the email body using the second encryption key.

Goldberg teaches the method of claim 2; however does not teach the encryption of email messages. Olkin teaches a secure e-mail system for the purpose of providing security in the transmission of email messages. Olkin et al. discuss

encryption of email messages using the public-key, and private-key based systems as being quite popular and is generally attributed to work done by Ron Rivest, Adi Shamir, and Leonard Adleman at the Massachusetts Institute of Technology in the 1970's [US 6584564 B2, Col 2, Ln 12]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the processing of multiple/separate email messages of Goldberg by adding an encryption process as discussed by Olkin et al. for the purpose of providing security in the transmission of email messages such as encrypting the first email body using a first encryption key, and encrypting the second email body using a second encryption key, such that the encrypted email messages now comprise the encrypted email body and the encryption key.

Goldberg does not teach the limitation regarding the hidden recipients concealment option for protecting the identity of one or more hidden recipients of an email message, wherein determining the one or more hidden recipients of the email message also includes selecting a hidden recipients concealment option; wherein further each of the one or more hidden recipients will receive, depending on the selected hidden recipients concealment option, either a second encrypted email message comprising, for each of one or more hidden recipients, an encrypted version of a second encryption key and a second encrypted email body created by encrypting the email body using the second encryption key, or a corresponding one or more encrypted email messages corresponding to the one

or more hidden recipients, wherein each encrypted email message of the corresponding one or more encrypted email messages comprises the second encryption key encrypted for a corresponding hidden recipient and a second encrypted email body created by encrypting the email body using the second encryption key.

Price III teaches a method/apparatus for the purpose of protecting recipient's identities by facilitating secure anonymous email recipients. Price III teaches sending a secured email message, wherein determining the one or more recipients of the email message also includes selecting a recipients concealment option [Fig 3, Step 302]; wherein further each of the one or more recipients will receive, depending on the selected recipients concealment option, either an encrypted email message comprising, for each of one or more recipients, an encrypted version of the encryption key [Col 2, Ln 25] and an encrypted email body created by encrypting the email body using the encryption key [Col 2, Ln 21], or a corresponding one or more encrypted email messages corresponding to the one or more recipients, wherein each encrypted email message of the corresponding one or more encrypted email messages comprises the encryption key encrypted for a corresponding recipient [Col 2, Ln 25] and the encrypted email body created by encrypting the email body using the encryption key [Col 2, Ln 21]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined invention of Goldberg and Olkin

et al. of processing of encrypted multiple/separate email messages by having a hidden recipients concealment option as taught by Price for the purpose of protecting the identity of the one or more hidden recipients from the other one or more hidden recipients of an email message.

b. Dependent claim 16 is merely the computer-readable medium having the computer-executable instructions of claim 15 that is also performing the method of claim 3. Claim 16 is rejected under the same analysis and rationale of rejecting claims 15 and 3.

c. Dependent claim 17 is merely the computer-readable medium having the computer-executable instructions of claim 15 that is also performing the method of claim 4. Claim 17 is rejected under the same analysis and rationale of rejecting claims 15 and 4.

d. Dependent claim 18 and 19 is merely the computer-readable medium of claim 13 and other computing devices having further computer-executable instructions of claim 15. Claims 18 and 19 are rejected under the same analysis and rationale of rejecting claims 13 and 15.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Jeriko P. San Juan whose telephone number is 571-272-7875. The examiner can normally be reached on M-F 7:30a - 5:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on 571-272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JOSEPH DEL SOLE
SUPERVISORY PATENT EXAMINER

2/26/07